
Supreme Court of the United States

OCTOBER TERM 1941

No. 37

THE CUNO ENGINEERING CORPORATION,
Petitioner,

VS.

THE AUTOMATIC DEVICES CORPORATION,
Respondent.

**BRIEF FOR PETITIONER ON WRIT OF CERTIORARI
TO THE UNITED STATES CIRCUIT COURT OF
APPEALS FOR THE SECOND CIRCUIT**

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BRIEF ON BEHALF OF PETITIONER ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

Opinions of the Courts Below

The opinion of the United States Circuit Court of Appeals for the Second Circuit holding claims 2, 3 and 11 of the Mead "Cigar Lighter" patent 1,736,544 (R. 289) valid and infringed by the Cuno Lighter, is dated February 3, 1941, reported in 117 F. (2d) 361, and is reproduced at pages 506 to 510 of the Record.

The opinion of the United States District Court for the District of Connecticut holding the claims of the Mead patent 1,736,544 if valid not infringed by the Cuno lighter is reported in 34 Fed. Supp. 146, and is reproduced at pages 483 to 497 of the Record.

The decision of the United States District Court for the District of Connecticut dated September 19, 1939, denying a motion for preliminary injunction on the Mead patent in this case will be found in 34 Fed. Supp. 144.

The opinion of the United States Circuit Court of Appeals for the Seventh Circuit holding the Mead patent 1,736,544 (R. 289) invalid as to claims 2, 3 and 11 and not infringed by the Sinko lighter in the case of *The Automatic Devices Corporation v. Sinko Tool & Manufacturing Company* dated April 27, 1940, is reported in 112 F. (2d) 335. The opinion of the United States District Court for the Northern District of Illinois in the *Sinko* case has been reported, so far as is known, only in 42 U. S. Pats. Quarterly 261.

Jurisdiction

This case is before the Court on a writ of certiorari to the Circuit Court of Appeals for the Second Circuit granted April 14, 1941 (R. 518), and limited to the question of whether claims 2, 3 and 11 of the Mead patent 1,736,544 (R. 289) are valid. The case was assigned for hearing immediately following the case of *The Automatic Devices Corporation v. Sinko Tool & Manufacturing Company* (then numbered 277, now No. 6) on the same question, there being a conflict in the decisions of the Circuit Courts of Appeal. Jurisdiction of this Court is founded on Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C. A. No. 347). The judgment which the defendant-petitioner seeks to have reviewed is dated March 10, 1941 (R. 518).

Statement of Case

This is a suit brought by the respondent, The Automatic Devices Corporation, against petitioner, The Cuno Engineering Corporation, in the United States District Court for the District of Connecticut for alleged infringement of claims 1, 2, 3 and 11 of the Mead patent 1,736,544 (R. 289) dated November 19, 1929, claims 3 and 20 of the Cohen patent 2,140,311 (R. 296) dated December 13, 1938, and claims 1, 2, 10, 16 and 18 of the Cohen patent 2,117,232 (R. 306) dated May 10, 1938.

The District Court, after full trial on the merits, held Mead's claims 1, 2, 3 and 11 of doubtful validity and not infringed by the Cuno lighter.

The claims of both of the Cohen patents were found invalid by the District Court. The Cohen patent 2,140,311 (R. 296) was dropped after the appeal was filed and claim 1 of Mead was dropped without warning at the time of the argument before the Court of Appeals.

The Circuit Court of Appeals for the Second Circuit affirmed the District Court on the Cohen patent 2,117,232 (R. 306) but found claims 2, 3 and 11 of Mead valid and infringed (R. 506).

A petition for corrections of factual errors and for a rehearing as to Mead was denied February 27, 1941 (R. 511), although three of the corrections requested were made.

Petitioner now seeks review of the judgment of the Circuit Court of Appeals so far as it concerns the Mead patent.

Your petitioner, a Connecticut corporation, is a manufacturer of long standing and has been responsible for many improvements in the cigar lighter art, including patents which form the basis for the Cuno and the Casco lighters and including the lighter used extensively by the Ford Motor Company and others.

The respondent does not make or sell anything. It is a mere patent holding company which has licensed Casco Products Corporation under these and many other cigar lighter patents without royalty or other consideration other than an agreement to pay the cost of patent development and litigation.

The Mead patent application was filed August 24, 1927. There is evidence that Mead was experimenting with a cigar lighter in 1927 and possibly in 1926 but no adequate evidence as to what the construction was. The evidence shows that the original construction was not satisfactory. A few improved lighters were placed on the market in

1928 after the patent application was filed, but failed of acceptance. There is no evidence that anyone has ever made or sold more than some 2,000 lighters of the later Mead type, many of which were returned.

Plaintiff-respondent contends for a construction of the Mead patent as a basic patent on a thermostatically protected cigar lighter broadly covering a so-called automatic wireless lighter and that Mead is entitled to credit for a commercial development which did not appear until 1936.

Not until 1936 did Casco Products Corporation (respondent's licensee) put on the market an automatic lighter.

Despite the fact that the Mead patent had then been issued seven years Casco found it necessary to make hundreds of experiments and large expenditures to produce a satisfactory commercial lighter.

The only objects set forth in the Mead patent are to produce "cigar lighters or devices of a similar nature"—which are "extremely simple and cheap in manufacture and more efficient than the devices used heretofore" (R. 291, lines 1-10). Nothing is said in it about wireless or cordless lighters or about signalling or safe driving. The patent contains no disclosure of a device like the Cuno lighter or any other commercially useful device.

It is our contention that Mead disclosed no useful device—that any new idea which may be found in his patent was an obvious one involving no patentable ingenuity—that the claims in suit are vague and inaccurate and do not meet the requirements of Section 4888 of the Revised Statutes. These claims fail to include sufficient elements to carry out any safety feature. The essential latch is missing from the claims. None of the claims are limited to a wireless lighter. All of the claims in suit are substantially anticipated by the prior art.

The so-called automatic safety feature for an electric heater was a "tool of the trade" which was an obvious addition to the lighter of the petitioner's Wolfson patent 1,980,157 (R. 433) filed in 1931 and later embodied in the Casco lighter.

The addition of a thermostatic latch to Morris 1,376,154 (R. 386) was an obvious idea before Mead.

It is our contention that the so-called automatic lighter is a natural development of the art which should be available to everyone.

The automatic lighter was made a success by the development work of Cuno, Casco and Sinko—not by Mead. Mead's device was not immediately adopted and never did drive others from the field. In fact it was a failure.

It is the contention of your petitioner that none of the commercial cigar lighters of the Cuno or Sinko types involve features which should be monopolized by virtue of the Mead patent.

The Mead patent was purchased by Casco Products Corporation May 3, 1934, and later transferred to plaintiff-respondent. Mr. Cohen in the *Sinko* case (R. 70) said that Mr. Johnson, their patent attorney, "discovered that the Mead patent was the one stumbling block"—and they later bought it.

Mr. Cohen claimed to have seen a Mead lighter in 1929 and although he thought it had possibilities "it was passed over rather lightly" (R. 74).

He later developed the Casco lighter after years of experiment and a large investment and in 1938 took out the Cohen patents originally in suit.

Manufacturing and merchandising ability in 1936 and later should not reflect credit on a device which failed in 1928.

The Casco lighter of plaintiff-respondent's licensee bears a notice of eight (8) patents under which it is claimed to be made and sold (physical Ex. 19 offered R. 37).

Mead therefore did not bring cigar lighters to "final form" as found by the Circuit Court of Appeals for the Second Circuit (R. 510).

The opinion of the United States Court of Appeals for the Second Circuit as to the Mead patent is in conflict with the opinion of the Court of Appeals for the Seventh Circuit as to validity and infringement of the same claims

by the Cuno and Sinko lighters which the plaintiff states are "substantially the same" (see respondent's motion for leave to file a petition for rehearing in the *Sinko* case p. 3).

Assignment of Errors

The general errors of the United States Circuit Court of Appeals for the Second Circuit relied upon are:

1. In finding and holding that claims 2, 3 and 11 of the Mead patent 1,736,544 (R. 289) are valid and in not finding and holding that said claims are invalid.

2. In construing the patent on the unsuccessful Mead device to cover the successful construction of defendant-petitioner brought out about ten (10) years after Mead.

3. In failing to find the claims in suit invalid for failure to comply with the requirements of Section 4888, Revised Statutes.

Specific errors of the Circuit Court of Appeals for the Second Circuit relied upon are:

4. In finding in effect that Mead had remedied a defect in wireless lighters (R. 508).

5. In finding in effect that the evidence shows "that for seven intervening years the art had been making futile attempts at improving and refining upon his (Morris') disclosure" when Mead came into the field (R. 508).

6. In finding in effect that Mead led to a modification of the lighter of the Morris patent 1,376,154 (R. 509).

7. In finding that Mead brought the cigar lighter for motor cars to "final form" (R. 510).

8. In finding in effect that conception reduced to practice as shown by Mead is sufficient to sustain claims ap-

plicable to a wide variety of successful devices in contrast to the unsuccessful devices of Mead (R. 510).

9. In finding in effect that there is nothing in the prior art to require the Mead claims to be limited closely to the disclosure (R. 510).

Summary of Argument

1. The Mead lighter as disclosed in his patent was never sold.

2. A few improved Mead type lighters sold in 1928 were so unsuccessful that it was abandoned.

3. There is nothing in the Mead patent to lead one to suppose his device was an aid to safe driving or that it would give a signal when actuated or that it was limited to a wireless type of lighter.

4. Mead's alleged invention did not lead to modification of the Morris lighter as in effect found by the Circuit Court of Appeals for the Second Circuit (R. 509).

5. Mead did not bring the cigar lighter for motor equipment to its final form as held by the Circuit Court of Appeals for the Second Circuit (R. 510).

6. Thermostatic switches were common tools of the electric heater trade before Mead.

7. Copeland 1,844,206 (R. 425) shows the first automatic wireless lighter which anticipates the Mead claims in suit.

8. There could be no patentable novelty in supplying an ordinary thermostatic latch to the lighter of the Morris patent 1,376,154 (R. 386).

9. No successful automatic lighter appeared on the market until the Casco lighter in 1936 and this was radically different from anything disclosed by Mead's patent.

10. The success of automatic wireless lighters was due to the development work done by the Casco, Sinko and Cuno companies none of which ever made and sold a lighter like that of Mead.

11. The only novelty in the Mead patent was a supporting base with a pivoted socket, rotated by a heater plug, held by a latch and rotated backward by a spring.

12. The claims of the Mead patent are vague and incomplete and invalid for failure to comply with the requirements of Section 4888 R. S. which reads as follows:

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

13. The plaintiff-respondent, owner of the Mead patent, is not a manufacturer and never made cigar lighters as stated by the Circuit Court of Appeals for the Second Circuit (R. 507) and receives no royalty or other consideration from its licensee, Casco Products Corporation, except an agreement to pay for patent development and litigation.

14. It would be contrary to public policy as declared by the decisions of this Court to sustain the claims in suit.

15. We submit that the judgment of the Circuit Court of Appeals for the Second Circuit should be reversed and the judgment of the Circuit Court of Appeals for the Seventh Circuit affirmed.

Argument

An electric lighter for cigars, cigarettes, etc., is only a special kind of electric heater in which a resistance element is heated by the passage of electricity.

The patent in suit relates to improvements in "cigar lighters or devices of a similar nature". The type of cigar lighter here involved is one wherein a plug member carrying a heated electric resistor may be removed bodily from a socket to apply the heated resistor thereon to light a cigar or cigarette. Such removable plug type lighters were concededly old prior to the alleged invention of the patent in suit. They were sometimes called "wireless lighters". They have formed the basis for substantial commercial enterprises long prior to the advent of the devices here charged to infringe. The lighter plugs of these prior art devices were ordinarily carried in sockets. Those sockets contained contacts of an electric circuit designed to be completed by the resistor element of the plug to effect heating thereof. In such prior art devices the electric circuits were completed by manual pressure on the projecting end of the plug, usually against a spring resistance. On release of such pressure the circuit was automatically broken and heating of the resistor ceased.

Several years after the issuance of the patent in suit the manufacturers of these prior art devices, including petitioner here, produced devices wherein the time of application of electric energy to the resistor was automatically determined without required attention by the user. As will be obvious to even a novice in the electrical art,

this was accomplished by the well-known expedient of using a thermostat to break the electric circuit after a predetermined time.

Thermostats have long been used for this specific purpose in the electrical art. It was old to use such thermostats to prevent overheating of electric resistors in electric irons, heating pads, toasters and other electric cooking devices. Such thermostats were used both as a part of the electrical circuits and in the operation of latches controlling the switch mechanism in such circuits. Many circuit controlling thermostats of the prior art included bi-metal strips or coils having the property of abnormal distortion or bending under the influence of temperature changes.

Indeed the prior art foreshadows the utilization of this old and well-known control device, the thermostat, for controlling the electric circuit of a cigar lighter resistor. The prior inventor, Francis C. Copeland, patentee of Patent No. 1,838,363 (R. 419) and No. 1,844,206 (R. 425), provided thermostats for opening the electric circuits of cigar lighter resistors. One of these patents (Patent No. 1,838,363) emphasizes the obviousness of utilizing a well-known thermostat structure by alternatively suggesting the use of a thermostat for timing the circuit connection or the use of manual pressure against spring resistance for holding the circuit closed.

The patent in suit discloses a particular and specific cigar lighter structure which differs materially from petitioner's accused structures. Unlike such accused structures and unlike the similar plug type "wireless" lighters of the prior art which embody fixed sockets into which the plug is inserted, the patentee Mead employs a *rotatable socket* which is turned by the plug and heater member to close the electric circuit. A laterally extending pin projecting from the side of the plug in the Mead structure engages with a spring latch outside the socket to hold the plug and socket in the circuit closing position to which they have been rotated. Heat generated by flow of current

through the resistor is then stated by Mead to effect movement of a thermostatic spring device which causes release of the latch, permitting the plug and socket under influence of a spiral spring to be rotated back to an open circuit position. Thereafter the plug with its lateral latch pin may be withdrawn from the socket and its resistor applied to light a cigar or cigarette.

A principal advantage claimed for the commercial thermostatically controlled devices is that they promote safety in that they require no attention by the operator during the eight to ten second heating period when the plug resistor is connected in the electric circuit. That advantage is admittedly present in petitioner's accused device. This is not mentioned by Mead. Any advantage so attained in the device of the Mead patent is negated in the structure of that patent by the difficulty encountered by users in fitting the laterally projecting pin on the plug into a slot in the socket which is required for rotative purposes. This requires careful physical accuracy of at least the same degree required in fitting a key into a lock and more than offsets any possible advantage gained by obviating the necessity of attention during the short heating period.

In some heaters the resistance is exposed as in cigar lighters, toasters, stoves, etc., and in others it is enclosed as in sad irons, heating pads, coffee heaters, etc.

Harley 852,326 (R. 355) shows a simple form of electric heater for vulcanizing. Current passes through the resistance heating coils 7 to do the required work. The bimetallic thermostatic bar 13 adjacent the resistance coils opens the circuit at 14 at a predetermined temperature. Thus the degree of temperature attainable is automatically limited.

Thermostatic safety switches are of various kinds. Some are heated by adjacent resistors as in Harley 852,326 (R. 355). Others by coils wound around the bimetal such as in Stahl 1,372,207 (R. 379) where coil 19 is wound around

bimetallic latch 13 which holds pin 10 on plunger 8 in closed circuit position against the pressure of helical spring 9.*

Andrews 1,025,852 (R. 358) shows what he calls a "Cut out for Electric Heaters" embodied in a sad iron but in some claims covering an electric heater broadly with a thermostatic switch as in claims 1 and 5.

Plaintiff below has argued that "Andrews thermostat is controlled by the temperature of the body of the iron and not by the temperature of the resistance coil". This it says would not be satisfactory in a cigar lighter. These statements are just enough true to be misleading. The fact is that in both cases it is the temperature created in the vicinity of the thermostat that is effective. The temperature of the resistance coil in the lighter gets up as high as 1200° F., whereas the operating range of the thermostat is only about 300° F. The thermostat is put where it can operate without danger in the time allowed. This happens to be a short time which requires a very sensitive thermostat.

Denhard 1,143,572 (R. 363) shows another "Electric Heater" in the form of a sad iron, but claiming broadly a heating device which has a thermostatic device controlled partly by a switch in the handle as in claim 8.

Newsom 1,318,168 (R. 372) shows a coffee cooker controlled by a thermostatic switch in the base.

In the form of device shown in Fig. 3 of this patent the thermostat is operative under direct influence of the heater to permanently disconnect the electric circuit (R. 377, lines 27 et seq.). In the form of Fig. 4 the heating device is removable.

* In view of the frequent careless use of the term "spiral", we wish to state that we use the term "spiral coil" in its technical sense, to mean a coil, the turns of which lie in a common plane, whereas the term "helical coil" is used to describe a coil in which the turns are of substantially uniform diameter.

Mead's preferred form employs a spiral torsion bimetal spring for rotating his socket. All commercial retracting coils are helical steel compressed springs in the plug, not in or on the socket. Of course, the igniter coils are all spirals.

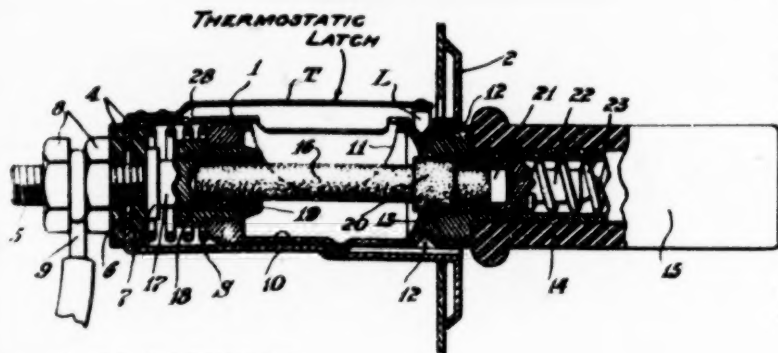
Each device of course has its own electrical and mechanical problems which must be solved before commercial success is achieved.

The earliest attempt at a wireless or cordless cigar lighter appears in the Adams patent 1,373,583 (R. 382). This involves the use of a removable plug with a carbon resistor H carried by a handle P and inserted into a socket B which has circuit terminals for connection to a battery so that when the plug is pushed in the circuit is closed and the carbon heated up. A spring E serves to push the plug out and open the circuit automatically when the handle is released.

Morris Patent

Morris 1,376,154 (R. 386) shows the same sort of device with a socket 1 and spring 28. The plug has a handle 15 and a carbon resistor 16. This patent owned by Casco Products Corp. contained a claim which they contended covered Sinko and Cuno lighters. The inserted sketch shows how simple and obvious a matter it would be to add a thermostatic latch to the Morris socket to hold the plug in the closed circuit position and thus add an automatic feature. This would not involve invention.

MORRIS 1,376,154 MODIFIED



The Zecchini patent 1,437,701 (R. 390) shows another early wireless lighter patent owned by Sinko Tool & Manufacturing Co. The Sinko lighter is a modification of this device.

The use of another thermostatic device is shown in Hurxthal 1,540,628 (R. 396) where the heat at the surface of a piece of toast actuates a thermostatic device 17 to release the bread carrier 6, produce a signal and open the circuit if desired (R. 398, line 18).

Metzger 1,622,334 (R. 401) shows a lighter with the resistor coil open at the front.

There were a number of different cigar lighters on the market from 1927 and 1928 on.

An improved form of the Mead device was on the market for a short time only in 1928, but it was a complete failure as will appear later on.

Cuno, Casco and Sinko have perfected the automatic and non-automatic lighters along lines wholly independently of Mead.

The Mead Patent

The objects of the Mead invention are described merely as to provide a device "extremely simple and cheap in manufacture and more efficient than the devices used heretofore". No other object is stated. Nowhere is it called "safe" or a "wireless" or "cordless" lighter nor are any of the advantages of the wireless type mentioned. The claims are not limited to a wireless lighter.

Two forms are shown. In each form there is a base assembly with a pivoted and rotatable socket and a plug or heater member which is inserted into the socket to rotate it and close the circuit. The base plate has a metallic latch member to which a wire terminal is attached and another wire terminal is attached to the rotatable metallic socket or to the base plate. Current is supplied from any source (but not from the igniter coil of a motor car as erroneously stated by the Court of Appeals, R. 507). The socket is

slotted and the plug has an igniter coil to the inner end of which a transverse contact bar or pin is connected which has to be fitted into the slot when the plug is inserted into the socket and the rim of the coil holder contacts with the socket. By turning or rotating the plug and socket until the contact pin engages the latch the circuit will be closed and the coil energized. A spring is mounted on the base assembly with one end fixed to the base plate and the other end connected to the socket for rotating the socket and plug to the Off or open circuit position. This spring 47 on sheet one of the drawing is of a flat spiral type mounted within the base of the socket immediately adjacent the igniter coil 83. The evidence shows that this was a fatal defect. The only form which Mead's company attempted to sell was changed to place the spring outside of the socket as shown at S in Exhibit C (R. 341). The bimetallic member 54 was supposed to warp when heated and withdraw from engagement with latch 52 so as to permit the spring 47 to rotate the socket and plug against the decreased resistance of the latch and pin 75.

In the form shown on sheet one the spring 47 is described as of bimetal which acts when heated to increase its torsional power sufficiently to overcome the tension of the spring latch 52.

Sheet two of Mead's drawing shows a helical tension spring 105 instead of the spiral spring 47 for rotating or retracting the socket and plug to the off position. In this form there is a bimetallic thermostatic member 54' which presses the spring latch 52 into position to hold the latch against the contact pin 75 when the device is energized. This member 54' is supposed to be heated in some way from the coil 83 but there is no evidence that such a device was ever used. It is doubtful if sufficient heat could be provided at this remote spot to actuate the bimetal quick enough to be of use.

Mead also suggests that the thermostatic element 54 might be heated by passing part or all of the current through it (R. 293, lines 104 et seq.).

The socket 41 has a slot 43 to permit one end of the transverse contact pin to pass freely without engaging the wall of the socket and a slot 44 to receive the protuberance 67 on the plug so that upon turning the inserted plug the socket will rotate but the contact pin 75 will not engage the socket. These slots and the cross pin make it necessary to insert the plug in only one definite rotated position which is obviously undesirable and extremely inconvenient.

Thus we see that although several modifications are shown there is no hint that the device is essentially a wireless lighter or that the invention could be embodied in anything but a rotatable socket and plug device.

There is no mention of any signal device or action such as implied as necessary by the Circuit Court of Appeals (R. 508).

It is obvious from the foregoing that Mead uses the socket and plug idea of Morris and Zecchini. Mead's device isn't suitable for insertion in a hole in the dash or instrument board but it does have the Zecchini igniter coil. The real novel features are the rotatable socket and the spiral bimetal return spring and latch. This was Mead's only contribution, which we will show was an utter failure.

So far as the claims in suit are concerned we understand that the plaintiff-respondent makes no claim of novelty except as to thermostatic control of a so-called wireless lighter.

It is our contention that the claims are not limited to wireless lighters at all and that they do not contain enough elements to cause the devices to function as useful automatic lighters.

Other Automatic Lighters

By some coincidence it appears that in 1926 and 1927 several people began thinking about applying a thermostatic switch for a cigar lighter.

Smith and Sons filed a British provisional specification December 14, 1926, and a complete specification June 2,

1927, on which patent 285,200 issued in 1928 (R. 316). This discloses a wireless cigar lighter with a bimetal thermostatic switch which opens the circuit when the "resistance filament attains a bright red glow".

Another British patent 298,073 (R. 467) was filed in 1928 by one Rupps based upon a German date of October 1, 1927. This, of course, is too late to anticipate but it shows another closely contemporaneous thermostatic cut-out for a cigar lighter.

Copeland

Copeland 1,838,363 (R. 419), filed March 9, 1927, before Mead, shows a cigarette dispensing and lighting device with an igniting coil 27 and a thermostatic switch member 38 (Fig. 10) to open the circuit "when a predetermined temperature is reached" (p. 2, line 90). This is a snap action thermostat which is latched "in" and snaps "out" when hot.

Copeland 1,844,206 (R. 425), filed April 18, 1927, before Mead, shows a lighter for cigars and cigarettes with a thermostatic cut-out or switch. In this structure a socket 11 is secured to the front board of a car and contains a movable and removable igniter coil 14 on an insulating base 15. This is supported on a buckling spring 23 adjacent a thermostatic switch member 24. When the holder 15 is pressed downwardly by a cigar or cigarette, the spring 23 presses against the bimetal member 24 and closes the circuit at 28. The thermostatic member is designed to operate to open the circuit and retract the heater member when the cigar is lighted.

Introducing an element of mystery into the case, plaintiff has contended that Mead has devised a device for opening the circuit when the heating (or igniter) coil reaches a desired temperature. This is cleverly misleading and not correct. Mead's device is merely a safety device or a timing device in the same sense as in other but prior electric heaters. It is the temperature of the thermostatic device itself which determines the opening of the circuit—not the igniter temperature.

Plaintiff's contention that there is some important difference between the thermostatic action of Copeland and that of Mead is not well founded. Mead (p. 3, lines 100-111) plainly says that the thermostatic element 54 may be heated *only* from the coil 53 (which is evidently intended for coil 83) *or* element 54 may be *connected in circuit* so that either the entire or part of the current must traverse the bimetallic element 54 and heat the same coincidentally with the heating of the lighting coil. This is what occurs in Copeland where the current passes through the resistance on the member 24 and also through the lighting coil 14. The thermostatic device of Copeland is no further removed from the lighting coil than member 54 is in Mead. It is a matter of degree. In Mead's patent use of bimetal in the main coil 47 is a "modification". Actually, in the only form of Mead offered in evidence the biasing or rotating spring 47 is the actuating thermostatic element. No one today suggests using bimetal in the retracting spring. No one uses a spiral spring.

Mead intended to include a thermostatic circuit opening device designed to operate when the igniter had had time to get hot enough. This will vary with the ambient conditions and with the energy input just as in Copeland. Copeland's thermostatic device is designed to open the circuit when the igniter has had time to get hot enough to light a cigar. This is a matter of experiment exactly as is the case in the Mead disclosure which gives no instructions as to how this is to be determined. If Mead's disclosure is sufficient, then Copeland's is equally good. Mead's device is nowhere described as a "wireless" lighter. To say that the temperature of the Mead heating member controls the action or that the "circuit is opened as the result of the igniter coil reaching a predetermined temperature, regardless of the time required", is not true.

It is also untrue that "in Copeland the circuit is opened as the result of the lapse of a predetermined time, regardless of the temperature of the igniter coil" as plaintiff has stated heretofore.

It is the rising temperature of the thermostatic device which causes the release action as in the prior art. The igniter coil in practice reaches a working temperature of approximately 1200° F. while the bimetal thermostatic latches only reach a temperature of approximately 300° F. unless the circuit is held closed as it can be in the Mead and Casco devices. In this way the bimetallic spring can be burned out. This is not possible in defendant's device.

Copeland's device is not essentially time controlled. Both Copeland's and Mead's devices are *energy* controlled. Action is subject to the temperature of the air and to the strength of the current supplied which affects the thermostatic device and the igniter coil at the same time.

The Court of Appeals in discussing Copeland 1,844,206 (R. 425) in effect admits that Copeland has all the elements of the Mead claims (R. 509), but held that "it did not lead to the necessary modifications of Morris' lighter". The Court discards Copeland's invention as "still born" but overlooks the fact that Mead's device as shown and described in his patent never even came to light. Even his improved form with the actuating thermostatic spiral coil outside of the socket died in its infancy.

Cohen, with Mead's device and with his many assistants, did not bring forth a Casco thermostatic lighter until 1936.

Plaintiff made much of the fact that Copeland used a separate thermostatic switch 24 instead of relying upon the heat from the igniter coil. There was nothing new in actuating a switch by the heat from a heater coil. That was an old tool of the trade. See Andrews 1,025,852 (R. 358), Denhard 1,143,572 (R. 363), Newsom 1,318,168 (R. 372). The Court of Appeals, moreover, found "that was, however, a difference of detail in design on which Mead's invention cannot rest". It in effect found Copeland to be a wireless lighter with all the elements of the Mead patent. To escape Copeland, however, the Court must have read into or implied the readily detachable plug and the latch and spring—elements which do not appear in Mead's claims

2, 3 and 11, although the latch is found in claims 6, 8, 9, 10 and 13, and the spring or equivalent will be found in claims 6, 8, 9, 10, 12, 13, 14 and 15.

Copeland Preceded Mead

Plaintiff attempted to carry Mead's date back of Copeland's filing on April 18, 1927, but without success. The evidence is not sufficient or of the character required for anticipation of a record date. Mead may have had something before April 18, 1927, but there is no adequate proof of what it was. The only dated drawing or description we find on pages 324 to 331. The date here is August 6, 1927, on page 330, and August 11, 1927, on page 328, evidently placed there by another than the writer of the notes. These notes were made for the patent attorneys and even then "Elmer" was not satisfied with his idea but wanted to "ask the patent attorney if this part (the spring) cannot be covered temporarily until the exact design and gauge of metal is decided upon" (R. 325).

Mead's Failure

It would appear from the testimony as to the Mead invention that the only form which went on the market embodied a latch spring for holding the plug in the rotated closed-circuit position and a flat spiral bimetal spring outside of the socket for rotating the socket back to open circuit position (R. 341). The patent does suggest a helical tension spring on sheet 2 of the drawing outside the socket for rotating the socket but there is no evidence of its use.

It does refer to a latch retracting spring 54 of bimetal. Head testified the latch was made of cold rolled steel.

There is no evidence that anyone else ever used a steel latch or a spiral return spring in a cigar lighter. No one ever used successfully a return spring in or on the socket

member for an automatic lighter. It will be noted that the return spring is in the plug in the Casco, Sinko and Cuno lighters.

Casco did use a spring in the socket in its non-automatic lighter like Cohen patent 1,944,925 (R. 429) but discarded it for the spring in the plug as in the Cuno Corporation's Wolfson patent 1,980,157 (R. 433) and Ashton's Ford type lighter patent 2,060,783 (R. 440).

Plaintiff's witness Mr. Head (R. 185, fol. 234) said **"we had plenty of trouble"** with Mead's device.

"I imagine the heat being so close to the heating element, affected the thermostatic metal" (R. 186).

"And it would not elick off the way it should."

"One thing we had to change our thermostatic spring"—"We took it from the inside, the bottom of the socket and put it on the outside."

The first few shipments to Montgomery Ward were returned—

"They just did not operate just right" (R. 189).

"Occasionally we would have returns" (R. 190).

It was quite a trick to get the proper thermostatic metal (R. 197 and 201).

"The latch was cold rolled steel."

"We tried bimetal up there"—it did not work so well (R. 203, fol. 252).

The Trial Court asked Mr. Head to explain why nothing was done about patenting the Mead device until after the company had sold out to Jessop (R. 200) and Head said:

"Well, I don't know—we had no money to get a patent—I would have **if it had been a success**"

Mr. Mead himself testified (R. 250) that the company went out of business. The testimony of plaintiff's wit-

nesses Dunsmore (R. 252), Johnson (R. 257) and Jessop (R. 268) all prove that Mead's device was just another unsuccessful "gadget".

That Mead himself did not regard his lighter as a success is shown by the testimony of Mr. Cuno as to what Mead told him.

"He stated to me that after considerable experimenting they finally made a sample which was delivered to Mr. Fisher, who at that time was President of the Cadillac Motor Car Company. He had that on his desk for several weeks, hooked up to a battery, and was quite excited about it at first, but after it failed to operate consistently he finally dropped the idea of putting them on as standard equipment on Cadillac cars. Some time after that a jobbing model was brought out, which was some time in 1928, a number of which were sold to the Montgomery Ward Company. And he told me that he was very much disappointed and disgusted by the fact that practically all of them came back after having been used a few times. The setting of the thermostat was evidently too delicate for ordinary operation, due to difference of temperature of atmospheric conditions. In summer-time, why, the temperature got up to a hundred and in the winter-time 22 degrees below zero, and his device did not work satisfactorily under all those conditions. In fact, he told me that he was so badly disappointed in the operation of the lighter that he finally quit his job with the company" (R. 100, fol. 127).

Plaintiff's Purchase of Mead's Patent

Plaintiff-respondent has endeavored to create the impression that Mead was the spark that set fire to Cohen and started the Caseo lighter into existence. We submit that the testimony on that point in the Sinko and Cuno records is quite unconvincing.

Mr. Johnson, president of the plaintiff company and its expert (R. 25), claimed to have seen and discussed a so-called Mead lighter (physical Ex. 12 offered R. 27) with

Mr. Cohen in 1929. This structure is shown in Exhibit C (R. 341). There was a lapse of eight years between the first time he saw it and the second time (R. 26, fol. 38). This Mead device had the spiral bimetallic spring wound around the outside of the socket. None of the Mead devices Johnson saw used bimetallic latches (R. 57, fol. 75).

In arguing for the allowance of a claim in a Cohen patent, Johnson said, as he admitted (R. 66, fol. 86):

"There is no thermostatic element or anything else in Mead for locating the plug in the base member until the igniting unit is heated a predetermined amount."

As this is a necessary feature of an automatic lighter, apparently Mead's patent did not disclose it sufficiently for Mr. Johnson, plaintiff's expert, to find it!

Mr. Cohen, president of Casco Products Corporation (plaintiff's licensee), testified as to the finding in 1929 of a sample of a Mead lighter in his "collection" (R. 74, fol. 95) "in fumbling through and searching" and it was **"discussed casually"**. "I remember clearly having stated that one day that would be the way to do it and it was passed over rather lightly at the time". At that time "we had more business on a lighter known as the '600' than we could actually supply".

This would not look as if there was any need for a lighter of the Mead type at that time.

Mr. Cohen then went on to say (R. 75, fol. 96):

"I did not think a great deal of the lighter as it was, since I knew we were confined to a very limited space, and **it looked like it was an impossibility** to introduce the mechanism, as I thought existed."

Then he could not sleep "along in 1931" until "finally it presented itself as if I could pick it up" (R. 75, fol. 97) and so he got up and "sketched it, and then went back to bed". Just what he found in the morning we do not know.

And so he sent for Mr. Johnson "with the idea of patenting, filing a patent **on what I thought was the greatest thing in the world**, and immediately proceeded to make samples. And **I could easily produce in this court a hundred more various types that we made before we actually made a successful lighter**".

"And so a **prolonged experimentation** was undertaken" (R. 76).

"And we had tried so many types and shapes of thermostats" (R. 76).

Then he turned the matter over to Mr. Johnson (R. 77), who made known the Mead patent which was purchased in 1934 (R. 17, fol. 26), and in 1936 assigned to the plaintiff.

The record shows that Cohen's first application was filed in 1932 and became patent 2,117,703 (R. 459) and a second filed in 1933 became patent 2,117,232 (R. 306) and even that was modified in the Casco 1936 commercial device by changing the latch fingers materially, providing stops between the fingers and adding a retaining device found necessary to prevent the plug from jumping out of the socket (R. 48, fol. 66).

And so it appears that the purchase of Mead's patent in 1934 was an afterthought—Mead was not the impetus to the automatic field.

Later Developments

The Circuit Court of Appeals for the Second Circuit was impressed with the time that intervened between the date of the Morris patent 1,376,154 (R. 386) and the Mead alleged invention and apparently deduced from this that a spark of genius must have appeared. It overlooked the basic character of the claims of the Morris patent and of the Zecchini patent 1,437,701 (R. 390) which undoubtedly retarded independent development of the wireless type of lighter.

Both of these patents were involved in the litigation between Casco Products Corporation and Sinko Tool & Manufacturing Co. in the Northern District of Illinois, Eastern Division (not reported). This same suit also involved the following patents of the Casco Products Corp.:

Hammond	1,620,548
Bain	1,657,189
Cohen	1,710,348
"	1,710,531
"	1,944,923
"	1,944,924
"	1,944,925 (R. 429)
Copeland	1,919,159

It is apparent that almost any cigar lighter, cordless or reel type, can be made automatic by the use of some form of thermostatic switch as in other electric heating devices. That is a feature to be expected as the commercial art progresses. The wireless lighter appears to have been first suggested in 1921. Various improvements followed from time to time. Copeland and Mead made no impression in 1927. Several others, including Casco Products Corporation, Sinko Tool & Manufacturing Company and The Cuno Engineering Corporation, started shortly thereafter. Wolfson (defendant's) patent 1,732,784 (R. 409) filed in 1928 and Cohen 1,944,925 (R. 429) filed in 1929 show early cordless lighters which met with some success. Wolfson 1,980,157 (R. 433) filed in 1931 shows the basis for the Casco automatic and was successful (see chart of sales on R. 315). The only change required to make it automatic was the formation of the contact 10 of bimetal with its tips bent into latches to engage the rim of the heater 9 as in the Casco lighter.

Cohen's first idea was to substitute the thermostatic form of the Hammarstrom patent 493,380 (R. 352) for Cohen's 1,944,925 (R. 429) contact. He afterwards applied the simplest form of bimetal latch to the Wolfson 1,980,157

(R. 433) device then on the market and under which Casco was at one time licensed by Cuno. It took him a long time, however, to get a device that would work satisfactorily and that could be made uniformly and commercially to meet the high standards of modern competition. He got no help from Mead—that is certain. In fact Mead's efforts probably misled the public into believing that an automatic lighter was impracticable.

The existence of the vague, inaccurate and indefinite claims of the Mead patent may have been a factor in delaying the development of a real automatic lighter.

The Ashton 2,060,783 (R. 440) so-called Ford type lighter was made and sold extensively both by Casco and by Cuno in the non-automatic form beginning in 1934, and is still being made and sold. Cuno's automatic is an improved form of this Ashton lighter.

The Casco automatic appeared in 1936. Sinko had previously modified an old Cuno lighter (item 1690) to make it automatic in 1933. None of them received any help from Mead's 1927-1928 failure.

It is obvious that there was no demand for an automatic lighter until it was created by Casco's 1936 lighter and its extensive 1937 advertising.

To credit Mead with any part of this development work, we submit, is to stretch the imagination beyond the elastic limit.

We submit, therefore, that the purpose of the patent law, i. e., to promote the progress of science and the useful arts, would not be carried out if the vague and indefinite claims on Mead's failure are sustained to cover the successful devices of Sinko and Cuno.

The Cuno Lighter

The Court has limited this case to consideration of the question of validity of claims 2, 3 and 11 of Mead although the Court of Appeals in the Seventh Circuit case held the claims not only invalid but not infringed. In the instant case the Court of Appeals for the Second Circuit has treated the Mead invention as broad and has not given us the advantage of a discussion of the form or substance of the claims.

It is difficult to draw a clear line of distinction between validity and infringement unless we are willing to coldly examine the actual invention and the claims in suit. We may find some sort of invention expressed in some claims and no invention in others. The fact that a patent may contain a novel idea does not justify a monopoly of all ways of realizing that idea. The patent can be valid only so far as the claims express a novel and complete device capable of utilizing that idea.

We will, of course, omit any comparison of the Cuno lighter with the claims.

In view of the fact, however, that we have felt it necessary to charge that the Mead device has never appeared on the market since 1928, we feel that we should give a brief description of the Cuno lighter in order that the Court may not get the impression as the Court of Appeals apparently did that the Cuno lighter is somehow similar to the disclosure of the Mead patent.

The Cuno lighter is shown on Exhibits A, 1-A, 1-B, 1-C (R. 277-282) and resembles somewhat the Ashton patent 2,060,783 (R. 440). It will be easier to understand from the drawings on pages 280 and 282 where there are reference numbers. The socket 10 is grounded and has lugs 17 which serve as stationary contacts. The bimetal fingers 16 are connected to bolt 12 and conductor 13 and constitute movable contacts.

The plug has an insulating body sleeve 18 into which the ring 23 is screwed. This ring has a wall 24 to which the stem 25 of the igniter unit is fixed. The igniter unit has a resistance coil 27 mounted in a cup 28 which is secured to the stem 25 and forms one plug contact. A metal sleeve 19 slides within the ring 25 and has a flange 35 which serves as the other plug contact. A stud 21 on which the knob 22 is mounted is secured to a disc 20 which forms the outer end of the sleeve 19. A spring 34 is interposed between disc 20 and wall 24 so as to normally press the knob 22 outwardly. When the plug is inserted into the socket the igniter contact rim 28 engages the lugs 17, 17 and the spring detent 36 in the socket wall engages in the groove 37 of the sleeve 18 to hold the plug in place.

To close the circuit the knob is pushed inwardly until the contact rim 35 engages the bent ends of the bimetal fingers 16, 16. Of course the igniter cup does not move and never touches the bimetal latch fingers. Heat is radiated from the igniter coil and eventually warps the latch fingers outwardly so as to release the contact sleeve of the plug and permit the spring 34 to retract the contact sleeve and thus open the circuit without moving or disturbing the igniter or heater member.

It will be noted that the plug can be inserted in any rotated position as there is no projecting pin as in the Mead patent.

The propelling spring is entirely in the plug where it is not likely to be damaged by heat from the igniter as in Mead's device. It is impossible to hold the contact rim 35 against the fingers 16 when they are warped by heat, hence the coil cannot be burned out as is possible in the Mead device. There is no rotary socket to get jammed and out of order. In fact the Cuno socket is entirely immovable. There is no bracket or base assembly with laterally disposed wire terminals as in Mead's patent.

The bimetal fingers 16, 16 act directly as contact latches and perform no other function whereas in the Mead device

the spiral rotating spring in one form is of bimetal and in another form supplements a bimetal latch holder 54 to control a separate latch.

The Casco Lighter

From the tenor of the decision by the Court of Appeals it appears almost inescapable that the Court had given Mead the credit for the commercial success of the Casco lighter.

This Casco lighter however is radically different from anything shown, described or claimed in the Mead patent. A drawing will be found on Defendant's Exhibit B (R. 340).

It will be recalled that Mr. Cohen testified to the large number of experiments all of which we presume were made after the inspiration of his dream.

The Casco lighter is similar to the Cohen patent 2,117,232 (R. 306) but shows a number of changes in construction which must have intervened between the date of filing of Patent 2,117,232 and the commercial lighter of 1936. Neither of them however shows a rotatable socket or a spiral bimetal throwing spring. In both cases the retracting spring is in the plug as in Defendant's Wolfson patent 1,980,157 (R. 433). The Cohen-Casco lighters show plugs with igniter coils which do move back and forth in making and breaking the circuits. In the Cuno and Sinko lighters however the igniter coils do not move in breaking the circuit. The circuit is broken by retraction of a sliding switch contact member.

This Cohen patent 2,117,232 was one of those urged against the Cuno lighter which was supposed to infringe it. The District and Appeals Courts however found the Cohen claims invalid. Doubtless the Cohen lighter is a great improvement over Mead but the Cohen claims were found not to cover the Cuno lighter. Mr. Johnson testified that the Casco lighter contained "many refinements and minor structural changes" (R. 37), "minor details which are

troublesome from an engineering point of view" (R. 45). All of which tends to show that there was no invention in the automatic idea, but there were real mechanical and electrical difficulties in developing a useful automatic lighter not solved by Mead.

The Record

In view of the fact that this Court is concerned only with the Mead patent, we might have condensed the record. We feared, however, that the Court would not get a correct view of the situation if reference to the two Cohen patents was deleted, since it was Cohen and his staff who were responsible for the step by step development of the first successful automatic lighters after the Wolfson 1,980,157 (R. 433) type was placed on the market but—we submit—wholly independently of Mead.

We do not overlook the invention of the Sinko auto-lighter in 1933, but this did not appear on the market until after the Casco lighter.

The various patents issued from 1931 on show that gradual improvements and refinements brought about by the intense competition of the age and the desire for "something different". This competition would be greatly retarded by sustaining claims like those of Mead in suit.

Mead Claims Invalid

It is our contention that the claims in suit lack invention and are invalid: 1st, failing to comply with Section 4888, Revised Statutes; 2nd, being broader than any disclosed invention; 3rd, for lacking inventive novelty; 4th, the claims are invalid because merely functional; 5th, the combination claimed produced no new result.

Claim 2 requires "means for moving said heating member". Nowhere does the patent describe such an element nor is there any such element. Plaintiff has contended that

this is the knob—but Judge Hincks correctly denied this. The knob is not “means for moving the plug” but merely means by means of which *it may be moved*. One is active—the other passive. If we refer to claim 1 which contains the same element we find that it is described as “on said base member” which must refer therefore to the socket with the slot 44 to be engaged by the protuberance 67 which serves “to drive and rotate the socket when the knob is turned” (R. 293, lines 10, 11).

The last phrase of claim 2 “means responsive to the temperature of said heating unit for interrupting said energizing circuit” is broader than the invention, incorrect and distinguishes from the art only by function.

This claim 2 does not include a latch or a spring, both of which are required by an automatic lighter. A mere ordinary warping switch member like that of Harley 852,326 (R. 355) would interrupt the circuit—and keep opening and closing the circuit as the bimetal heated and cooled.

Furthermore, it is not the temperature of the heating unit that actuates the circuit breaker—it is only such heat as is created by the passage of current through the bimetal and by radiation and convection from the heater coil. The latch and the spiral throwing spring never reach anything like the temperature of the heater coil. This is pertinent because of the plaintiff's argument that Copeland 1,844,206 (R. 425) has its thermostat 24 too far away from the igniter coil to be affected by its temperature. This claim is not even limited to a cigar lighter.

The current supply terminals are not clearly defined in the patent—presumably the term refers to terminals 58 and 59, but they do not constitute any combinable feature with the other elements.

This claim 2 requires the heating member to be “removable”, but so is any cord type lighter plug—so is that of Copeland. The Court should not read into the claim any of the peculiarities of a wireless or cordless lighter to save the claim. That would be contrary to the law and public policy.

White v. Dunbar, 119 U. S. 47, 30 L. E. 303.

Carlton v. Bokce, 84 U. S. 463, 21 L. E. 517.

Howe v. National Co., 134 U. S. 388.

Claim 3 differs somewhat from claim 2, but it has similar defects and is therefore invalid. It is not limited to a wireless lighter. Every cord type lighter has a removable heating member—and so does Copeland although not for the same purpose.

So far as this claim is concerned it is even broader and more indefinite than claim 2 as it calls for a mere "support" for the heating member rather than a socket. The current supply terminals on the support must be elements 58 and 59 which perform only the usual function of current supply—not related in any way to the other elements of the claim. The method of support of the heating member is described in a purely functional manner.

Here again there is no latch or spring required. There is merely "means responsive to the temperature of said heating unit for controlling the heating thereof". This means is the same as in claim 2, but is further faulty in that it calls for "controlling the heating". A switch which merely opens a heater circuit cannot be said to control the heating. This term "control" implies at least that it can increase or decrease, whereas Mead's switch can only open the circuit. As pointed out with respect to claim 2, it is not the "temperature" of the heating unit, but the heat transmitted through the air or by passage of current through the thermostat itself. This claim is too broad and indefinite to be valid.

Claim 11 is also invalid for the same general reasons as claims 2 and 3. Furthermore, this claim does not even require that the heater member be removable—only movable—which defines Copeland's igniter exactly. This claim calls for a base member, but omits the essential socket. Here again the "electrical supply terminals" are on the base member with no patentable relation to the other elements. The heater member is functionally located as movable between an energized position and an off position. This claim adds "automatic means for withdraw-

ing said heater member from the on position to the off position *upon* heating of said heater". This phrase is similar to one in claim 12 which Mr. Johnson, the president of the plaintiff company and its expert, said in the *Sinko* case (*Sinko* R. 49) was incorrect or inaccurate because the heater member is not withdrawn—it stays where it was when heated—it merely rotates. Furthermore, this claim reads exactly upon Copeland.

It will be noted that there is no relation between the heater and the "automatic means". It acts "*upon* heating of said heater"—which means at the time of or when the heater is heated which is exactly what Copeland does whether you consider that it is the heat from the heater or from a coil on the bimetal bar itself which opens the circuit.

This claim is much broader than the invention because it is not even limited to a thermostatic device.

Plaintiff has taken the position that the Mead invention opened the circuit and kept it open and that it indicated when the circuit was open. No such requirement will be found in claims 2, 3 or 11.

The District Court in the *Sinko* case held:

"The essential features of the device, as it appears to me, were the combination of the spring and the thermostatic device in a cigar lighter and this combination I think revealed invention" (*Sinko* R. 241).

However, claims 2 and 3 do not require springs and claim 11 does not require a thermostatic device and none of them requires a latch which is essential for an automatic wireless lighter.

We submit, therefore, that the claims in suit are invalid for the reasons given. They are essentially met by Copeland's patent 1,844,206 (R. 425) and involve no invention over Morris and Zecchini in view of the common use of thermostatic switches in connection with electrical heaters. The device as claimed would produce no unexpected result.

The claims of Mead are literally anticipated word for word by the construction shown in Fig. 2 of Copeland 1,844,206 (R. 425) if given any broad scope.

Copeland Anticipates Mead's Claims

CLAIM 2 OF MEAD (R. 294)

In a device of the class described,
a removable heating member

having an electrical heating unit,
a socket for receiving and holding
said heating member,

electrical current supply terminals,

means for moving said heating member to a position for establishing an energizing circuit to said heating unit, (no means for moving is described in the Mead patent but only a handle whereby the heating member is moved and a guide for directing the rotary movement of the heating member)

and means responsive to the temperature of said heating unit for interrupting said energizing circuit.

NOTE: Mead's spiral throwing spring was so close to the igniter coil as to be unsatisfactory.

FIG. 2 OF COPELAND 1,844,206 (R. 425)

A cigar lighter

heating member 15, and tubular extension 16 (the degree of removability is not set forth in the claim)

resistance heater 14

the socket is formed by the guide member 11 and the extension 16

the terminals are connected to the control wires 26, 27, 29 and 30

the cigar when pressed against the member 15 causes the heater to be moved about its pivot 22 causing the spring 23 to be flexed in an opposite direction and about the center of the bimetallic arm or thermostatic bar 24 causing the switch 28 to be closed and the heater 14 to get hot by its being connected with the battery 25

the bimetal arm or thermostat 24 is heated to a large extent by the wire wrapped around it and both it and the heater 14 are simultaneously heated by the same current, since they are in series with the battery. They therefore both become heated simultaneously so that the bimetallic arm flexes away from the contact 28 to open the circuit in response to or as the heater 14 gets hot. The bimetal arm 24 flexes to return the buckling spring 23 to the position illustrated in Fig. 2 and at the same time opens the circuit through the switch 28.

CLAIM 3 OF MEAD

a lighting device for cigars and the like,

removable heating member

ring an electric heater,

support for receiving and holding said heating member,

current supply terminals on said support,

said heating member being movable on said support to a position where said heating unit is energized from said terminals

and means responsive to the temperature of said heating unit for controlling the heating thereof. (said does not control the heating of the heater 24 by keeping it at any predetermined temperature but is only effective to stop heating it after it has attained a desired temperature.)

FIG. 2 OF COPELAND

An electric lighter for cigars and cigarettes, (lines 1 and 2 of page 1 of the patent R. 490)

a heating member 15 with the tubular extension 16 removable from the guide tube 11 by means of the bayonet joint or pin and slot connection 17

coil 14

the lower end of the tubular extension 16 constitutes a support for receiving and holding the heating member 15

the wires illustrated lead to terminals on said support

this occurs when the buckling spring 23 is bowed downwardly from the position illustrated in Fig. 2 so as to close the circuit through the switch 28

since the main heater 14 and the auxiliary heater wound around the bimetal arm 24 are both connected to the same source of current and are in series, as one heats up the other does likewise so that the bimetal arm bends to open the circuit in response to or as the heater 14 gets hot. When the bimetal arm 24 flexes enough it opens the circuit at the contact 28 and thus cuts off further heating.

CLAIM 11 OF MEAD

In an electric lighter of the class described, a base member,

a heater member movably mounted on said base member,

an electric heater on said heater member,

electrical supply terminals on said base member,

said heater member being movable between an energized position where a circuit is established from said terminals to said heater, and an off position where said circuit is interrupted,

and automatic means for withdrawing said heater member from the on position to the off position upon heating of said heater.

FIG. 2 OF COPELAND

Either the tubular extension 10 or the guide 11 constitutes a base member

the heater member 15 is pivotally mounted at 22

an electric heater 14 on the heater member or refractory base 15

the terminals for the wires illustrated are electric supply terminals on the base member

the heater members 14 and 15 are pivotally movable from the position illustrated in Fig. 2 to a position closer to the bimetal arm 20 in which the spring 23 is bowed oppositely, the arm 24 is pressed downward by the spring and the circuit is closed at the contacts

as previously described when the bimetal strip 24 gets hot enough it flexes upwardly to open the circuit at the contact 28, snap the spring 23 back to the position illustrated and this movement of the spring also causes the heater member 14 and 15 to be swung upwardly to their position shown in Fig. 2 in which the circuit is broken.

Inasmuch as the claims of Mead are literally anticipated by Copeland 1,844,206 (R. 425), it should not be necessary to consider the changes over Copeland as did the Circuit Court of Appeals for the Second Circuit because these differences over Copeland are only found by improperly implying limitations into the Mead claims.

The Court of Appeals for the Second Circuit, in upholding the patent, made no examination of the separate claims in suit, but treated the patent as though they were for an automatic wireless or cordless lighter with the elements it considered necessary for a cordless lighter, i. e., a socket, a removable cordless plug with a heater coil, movable to close the circuit, a latch for holding the plug in closed circuit position, a thermostatic device responsive to heat created by the heater coil for retracting the latch and means for breaking the circuit and indicating the completed action to the user.

No such device was claimed by Mead or granted by the Government.

If there had been any such claim in the patent, the public would have been warned. The claims are supposed to define the limits or boundary of the patented domain. The public is entitled to know where the fence is in order that it may not in ignorance trespass upon a Government grant. An invisible or elastic fence is no fence at all.

Growth of Non-Automatic Lighters

The Court of Appeals made the peculiar remark, with respect to Zecchini, Metzger and Langos, "None of these differed basically from Morris, and they show that during the seven intervening years the art had been making rather futile attempts at improving and refining upon his disclosure" (from 1922 to 1929). And it is upon such reasoning that the Court of Appeals sustained plaintiff's case. Even if these efforts were futile, that has no bearing on the questions herein. Actually, the record (physical Ex. 26, offered R. 81) shows the growth of non-automatic lighters by Cuno and Casco from 1,157,000 in 1934 to 1,964,000 in 1935 and 2,066,000 in 1936. Total sales of all lighters were 2,375,000 in 1937 but fell to 1,379,000 in 1938. Of course, the Sinko lighter was in the market at the same time. Certainly Mead made

no contribution to this business. Mead made no "new and fruitful combination". His combination was a complete failure. He did not bring to "final form a contrivance which had become a standard fixture in motor cars". We doubt if after these thirteen years of failure a single lighter of the Mead form could be found in use.

The fact that it took nearly eight years after Mead's improved device was on the market and hundreds of experiments or samples before Casco, with its enormous facilities, could put a successful lighter on the market certainly does not establish immediate adoption of anything that Mead contributed. The suits of Automatic Devices Corporation against Cuno and against Sinko and the suits by Casco Products Corporation against Sinko Tool & Mfg. Co., involving twelve patents on cigar lighters, where all the patents were held invalid or not infringed or dropped, show the extent to which this plaintiff and its licensee have gone to control and stifle the development of the art. We submit that no such vague patent on a useless device should be now upheld to block the path of progress.

The fact that there is a conflict between the two courts of appeals on the question of validity and infringement is strongly indicative that the claims in suit are not so clear and distinct as to comply with Section 4888. It would not appear that the public should be expected to know the scope of a patent when two such courts reach diametrically opposite views on the same claims and as to structures which the plaintiff holds are "substantially similar".

Attempt to Monopolize Automatic Lighters

This is an attempt to monopolize an automatic feature in cigar lighters by means of a vague patent which makes no suggestion of safety, discloses a device which was never sold in the form shown and which in an improved form

was a failure. The patent is indeed a paper patent held by a corporation which does not manufacture or sell anything and which receives no royalty or other consideration for the use of the Mead and many other patents except an agreement to pay the cost of patent litigation and development. We submit that it would be contrary to public policy to sustain such claims as these.

Seventh Circuit Case

The decision of the Circuit Court of Appeals for the Seventh Circuit involves a record which in some respects is similar to the record in the instant case. Of course, the defendants' structures in the two cases are somewhat different, although plaintiff-respondent has contended that they are substantially alike.

In the Seventh Circuit case the Court found the Mead claims invalid and not infringed. That Court had before it a number of references not in the instant Cuno case.

In the Sinko case no especial stress was laid upon the Morris patent, which shows a type of cigar lighter involving a fixed socket and a removable plug as hereinbefore discussed.

In the Seventh Circuit case, as in this case, the plaintiff endeavored to show completion of the Mead invention prior to the filing of the Copeland patents, but without success.

In the present case, there is considerably more testimony showing the difficulty which Mead had in attempting to produce a workable device. There is also the testimony here of plaintiff's witness Head to the specific effect that the Mead device was not a success (R. 200).

It is therefore noteworthy that the Circuit Court of Appeals for the Seventh Circuit held invalidity of the claims in suit and lack of infringement upon a record in some respects more favorable to the Mead patent than the record in the instant case.

In that case Mr. Cohen, president of the Casco Products Corp. (licensee under Mead), testified that Mead was a "stumbling block" (Sinko R. 70).

The Court of Appeals for the Seventh Circuit held with respect to the Sinko lighter (Sinko R. 511):

"It is obvious that there is nothing found in defendant's device which is not found in Zecchini, and in Copeland No. 1,844,206, and we think the same may be said with respect to Mead. Plaintiff, however, contends that Copeland's device is not an automatic wireless cigar lighter. With this we cannot agree. Of course, all cigar lighters have wires whether they be automatic or what is termed wireless, that is to say they have those wires which conduct electricity. We suppose, however, that a wireless cigar lighter is commonly understood to mean one in which all connection of the plug to the device is severed when the plug is withdrawn from the socket. But even so, we think **Copeland is an automatic wireless cigar lighter.** It is not only wireless in the popular sense, but it is plugless. It provides for the insertion of a cigar in the socket instead of a plug, and the cigar is lighted before it is withdrawn from the socket. The cigar is inserted in a tubular guide and thrust inwardly until the circuit is connected, at which time the end of the cigar rests upon the heating unit, which heating unit remains in the socket. The connection is held until the heating unit becomes incandescent, and the cigar is lighted, at which time the heat from the heating unit operates the thermostat to release the cigar and its guide from the heating unit and they return to their normal position.

Before the Mead disclosure wireless cigar lighters were old, wherein the heating unit was on the end of the plug and the plug was removed for the purpose of lighting the cigar. All that Mead did was to cause the thermostat to operate on the plug in effect the same as Copeland permitted it to operate on the cigar. We do not feel justified in holding that this amounted to invention, in view of the fact that wireless plugs without the thermostat had been used so long, and in view of the further fact that the same principle of thermostatically disconnecting the circuit had been used in the

manufacture and use of electric irons, and the like. We think the fields are quite analogous, and since all of Mead's elements were quite old in both fields and he made no use of any new principle, we think his disclosures amounted to nothing more than mechanical skill, and we think the claims herein relied upon are invalid."

Of course the Cuno lighter follows generally the Morris type of device with the contact latch in the socket but the action is the same as in the Sinko lighter which follows Zecchini in having the switch contacts inside of the plug.

Each employs a simple form of thermostatic latch and neither uses a rotating socket or a bimetallic spiral throwing spring.

The "Last Step" Not Mead's

Plaintiff-respondent contends for validity and infringement based upon the idea that Mead made the last step which led to commercial adoption and success and has heretofore cited cases where the Court has sustained doubtful claims. In fact, the Circuit Court of Appeals in this case has cited cases supposedly justifying a finding of validity here. We submit, however, that in every such case cited there has been a wholly different state of facts.

We will first mention the cases cited by the Court of Appeals.

Potts v. Creager, 155 U. S. 597. In that case the patented machine had been a success and the defendant's machine was substantially like it. The closest reference was held to have been an abandoned experiment. Other reference were in non-analogous arts. No such situation exists here.

Regar v. Scott, 63 F. (2d) 229. This case was dismissed for non-infringement and does not appear to be authority for sustaining the Mead patent.

Patent Royalties Corp. v. Land O'Lakes, 89 F. (2d) 624. There the Court found "that the patent had quick and

almost universal acceptance" and that "the patent was a long advance; it gave the trade a new protection it had sought for many years". Such is not the case here.

Kelley v. Coe, 99 F. (2d) 435. Here the Court found that Kelley succeeded where all others failed. Kelley had received a medal from the Franklin Institute and was recognized as a benefactor. But even here there was a dissenting opinion.

Cases like *Frost v. Cohn*, 112 F. 1009, are not pertinent because in that case there was a narrow claim specifically copied by the defendant and shown in that form to be of great value.

The same is true in *O'Rourke Engineering Co. v. McMullen*, 160 F. 933. The claim was specific,—the invention of great value.

Similarly in *Bundy Mfg. Co. v. Detroit Time Register Co.*, 94 F. 524, the invention had marked a decided step and proven of great value. Here Mead made no useful contribution.

Other cases involving the resolving of doubt in favor of the "last step" lack pertinence here because in each the Court found either immediate adoption and public recognition or close copying of specific claims or both. No such facts are present here.

In the *Diamond Rubber Tire* case, 220 U. S. 428, there was a very specific claim which had been slavishly copied.

The *Barbed Wire Fence* patent, 143 U. S. 275, presented a narrow claim and almost universal adoption of the specific construction.

In the *Incubator* case of *Smith v. Snow*, 294 U. S. 1, the method involved was shown to be of very great utility and essentially copied.

The decision of Mr. Justice Lurton in *National Malleable Castings Co. v. Buckeye*, 171 Fed. 847, is also believed to be pertinent.

In the instant case Mead tried and failed. Commercial success eight years later was achieved only by radically different devices.

The Decision of the United States Circuit Court of Appeals for the Second Circuit Conflicts With Many Decisions of This Court

We have been unable to find a single decision of this Court which seemed to us to sustain plaintiff's contention and the decision of the Circuit Court of Appeals for the Second Circuit.

We submit that to sustain claims such as herein involved would not promote the progress of science and the useful arts as provided in the Constitution but would encourage an unlawful monopoly.

The following cases appear to your Petitioner as stating the law applicable to the facts shown herein.

A patent on an imperfect, unsuccessful device should not block progress.

Deering v. Winona Harvester Works, 155 U. S. 286.

Atlantic Works v. Brady, 107 U. S. 192.

Clark Thread Co. v. Willimantic, 140 U. S. 481.

On old device applied to a new use is not patentable.

Dunbar v. Meyers, 94 U. S. 187.

Bridge v. Excelsior Co., 105 U. S. 618.

Atlantic Works v. Brady, 107 U. S. 192.

Aron v. Manhattan Railway Co., 132 U. S. 84.

County of Fond du Lac v. May, 137 U. S. 395.

Miller v. Eagle, 151 U. S. 186.

Roberts v. Ryer, 91 U. S. 150.

Mere aggregations of well known elements resulting only in the expected results are not patentable.

Hailes v. Van Wormer, 20 Wall. 353.

Office Specialty Co. v. Fenton Co., 174 U. S. 492.

Grinnell Co. v. Johnson Co., 247 U. S. 426.

Thatcher Co. v. Burtis, 121 U. S. 286.

Royer v. Roth, 132 U. S. 201.

Reckendorfer v. Faber, 92 U. S. 347.

McCarty v. Lehigh Valley R. R., 160 U. S. 110.

Powers-Kennedy v. Concrete Mixing Co., 282 U. S. 175.

Claims which differ from the prior art only in functional statements are invalid.

Burr v. Duryee, 68 U. S. 531.

Westinghouse v. Boyden Co., 170 U. S. 537.

LeRoy v. Tatham, 14 Howard 156.

O'Reilly v. Morse, 15 Howard 62.

The law and public policy demand that the inventor clearly state what he claims.

White v. Dunbar, 119 U. S. 47.

Altoona Public Theatres v. American Tri-Ergon Corp., 294 U. S. 477.

Merrill v. Yeomans, 94 U. S. 568.

Beidler v. United States, 253 U. S. 447.

Carlton v. Bokee, 84 U. S. 463.

McClain v. Ortmyer, 141 U. S. 419.

Office Specialty Co. v. Fenton, 174 U. S. 492.

General Electric Co. v. Wabash Corp., 304 U. S. 364.

Claims should not be sustained by implying essential elements which are not actually required by their terms.

McCarty v. Lehigh Valley R. R., 160 U. S. 110.

Carlton v. Bokee, 84 U. S. 463.

White v. Dunbar, 119 U. S. 47.

Altoona Public Theatres v. American Tri-Ergon Corp., 294 U. S. 477.

Permutit v. Graver, 284 U. S. 52.

Phillips v. Page, 24 Howard 164.

Day v. Fair Haven Co., 132 U. S. 98.

Elements which are found in one claim should not be read into or implied into another claim to save it from anticipation. This specific point is not found in the decisions of this Court although we feel that it is covered broadly in the doctrine clearly stated in *White v. Dunbar*, 119 U. S. 47, and the following cases:

McCarty v. Lehigh Valley R. R., 160 U. S. 110.

Altoona Public Theatres v. American Tri-Ergon Corp., 294 U. S. 477.

Keystone Co. v. Phoenix Co., 95 U. S. 274.

Circuit Courts of Appeal have expressed disapproval of the special case as above stated in

Motoshaver, Inc. v. Schick, 112 F. (2d) 701 (C. C. A. 9).

Kennedy v. Trimble, 99 F. (2d) 786 (C. C. A. 2).

Success only is not a proper criterion of patentability.

McClain v. Ortmyer, 141 U. S. 419.

Thropp's Co. v. Seiberling, 264 U. S. 320.

Altoona Public Theatres v. American Tri-Ergon Corp., 294 U. S. 477.

Grant v. Walter, 148 U. S. 547.

Commercial success of one form of device should not be credited to a radically different disclosure.

Deering v. Winona, 155 U. S. 286.

Unity Co. v. International Corp., 57 F. (2d) 945 (C. C. A. 7).

Adt v. Bay State Co., 226 F. 925 (C. C. A. 1).

Acceptance of licenses under a number of patents is not conclusive as to patentability of one of them.

Thropp's Co. v. Seiberling, 264 U. S. 320.

A detail improvement patent is not entitled to a broad interpretation.

Boyd v. Janesville Co., 158 U. S. 260.

Conclusion

We submit therefore that the judgment of the United States Circuit Court of Appeals for the Second Circuit should be reversed.

Respectfully submitted,

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